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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,308	03/29/2001	Usman A.K. Sorathia	82,222	7684

7590 10/16/2002

Naval Surface Warfare Center
Carderock Division Headquarters
David Taylor Model Basin
9500 MacArthur Boulevard
West Bethesda, MD 20817-5700

EXAMINER

FEELY, MICHAEL J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 10/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

TC-11

Advisory Action	Application No. 09/822,308	Applicant(s) SORATHIA, USMAN A.K.	
	Examiner Michael J Feely	Art Unit 1712	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 September 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

- 1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
- 2. ☒ The proposed amendment(s) will not be entered because:
 - (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

- 3. ☐ Applicant's reply has overcome the following rejection(s): _____.
- 4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
- 5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
- 6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- 7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 2, 7, 9, 12-14, and 16: 35 USC 112 2nd; 5 and 11: 35 USC 103.

Claim(s) withdrawn from consideration: _____.

- 8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
- 9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
- 10. ☐ Other: _____

Continuation of 2. NOTE:

New issues raised:

The proposed changes to claims 2, 9, 12, and 13 have incorporated the subject matter of cancelled claim 1 (previously the parent claim of 2, 9, 12, and 13). The language incorporated into these claims is incomplete for omitting essential steps. It is unclear if the phrase "during fabrication" refers to the fabrication of the composite, the fabrication of the barrier, or the fabrication of the substrate. In addition, it is unclear if the phrase "formation thereof" refers to the formation of the fire resisting agent or the formation of the barrier. The same claim language was introduced to claim 1 in amendment A (paper #4), rejected in the second non-final rejection (paper #5), and properly amended in amendment B. Claim 1 was then later cancelled in amendment C (paper #8). Applicant has failed to incorporate the clear and concise version of claim 1 into claims 2, 9, 12, and 13. Similarly, the proposed change to claim 16 has incorporated the subject matter of cancelled claim 15 (previously the parent claim of 16). The claim language contains a similar defect by using the phrase "formation thereof". It is unclear if the phrase "formation thereof" refers to the formation of the fire resisting agent or the formation of the barrier.

Applicant has failed to address the rejection of claim 7 under 35 USC 112, 2nd paragraph. Claim 7 remains dependent upon claim 4, which is a cancelled claim. Claim 7 remains as an incomplete claim.

The proposed changes to claims 2, 9, 12, 13, and 16 would be still subject to the prior art rejections set forth in paragraphs 4-5 of paper #7 and paragraphs 11-12 of paper #5. The subject matter of these claims was never indicated as allowable subject matter; however, it appears that the Applicant may think otherwise. A prior art rejection was not made in the second final rejection (paper #9) for claims 2, 7, 9, 12-14, and 16 because these claims were, and still are, incomplete for being dependent upon a cancelled parent claim. In addition, in Applicant's response prior to the second final rejection (amendment C: paper #8), Applicant stated, "In order to place the present application in better condition for allowance, the foregoing amendment to the claims is submitted, merely involving cancellation of all claims except claims 5 and 11". Based on this statement, it appears that the failure to cancel claims 2, 7, 9, 12-14, and 16 was an oversight by the Applicant.

It should be noted that if Applicant plans to amend claims 2, 7, 9, 12, 13, and 16 to overcome the 112 issues, the Examiner will be forced to issue a final rejection of claims 2, 7, 9, 12-14, and 16 based on the prior art rejection of these claims set forth in paragraphs 4-5 of paper #7 and paragraphs 11-12 of paper #5. It should also be noted that claims 5 and 11 remain rejected for the reasons set forth in paragraph 7 of paper #9.



Robert Dawson
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